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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,012

09/11/2003

John Arthur Ricketts

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IBM CORP. (WIP)

c/o WALDER INTELLECTUAL PROPERTY LAW, P.C.

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EXAMINER

PARK, GEORGE M

ART UNIT

PAPER NUMBER

4114

MAIL DATE

DELIVERY MODE

10/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/660,012		RICKETTS, JOHN ARTHUR	
	Examiner		Art Unit	
	George Park		4114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/11/2003 and 11/13/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The term “IT simulation 218” (page 8, line 1) should be --IT simulation 216--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

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application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4, 8-14 and 18-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7-13 and 16-19 of copending Application No. 10/666,868. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/666,868 deals with spending inputs while the current patent application deals with benefits inputs. The Examiner takes the position that spending inputs are a form of benefits inputs (i.e. spending less money) since when an organization or business spends money on a benefit the organization or business essentially procures a benefit.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelking et al. (U.S. Pub. No. 2005/0049911 A1).

Regarding to claims 1, 11 and 18, Engelking et al. discloses the invention substantially as claimed. Engelking et al teaches a method, system, and computer-usable medium (i.e. computer-readable media), having computer-executable instructions (paragraph [0007], lines 1-10, paragraph [0009], lines 1-5, paragraph [0028], lines 1-16, see claim 15), said method, system, and computer-usable medium for simulation (i.e. modeling) (paragraph [0006], lines 1-3) comprising: means for receiving for at least one business transformation outsourcing service (paragraph [0007], lines 21-25) costs inputs (paragraph [0055], lines 5-9, paragraph [0056], lines 1-5, paragraph [0060], lines 1-2), process inputs (i.e. implementation/process costs) (paragraph [0062], lines 1-5, paragraph [0063], lines 1-9, paragraph [0088], lines 1-3 and 8-13), information technology inputs (i.e. technology costs) (paragraph [0033], lines 1-3 and 13-21, paragraph [0060], lines 12-16, paragraph [0071], lines 1-4, paragraph [0075], lines 1-4), and value inputs (i.e. stock price) (paragraph [0056], lines 5-9); means responsive to said inputs, for performing a cost simulation (paragraph [0092], lines 1-4, paragraph [0093], lines 1-6), a process simulation (i.e. implementation) (paragraph [0062], lines 1-11, paragraph [0092], lines 1-4, paragraph [0127], lines 1-7), an information technology simulation (i.e. technology/equipment upgrades) (paragraph [0041], lines 1-9, paragraph [0092], lines 1-4); and a value simulation (i.e. economic impact) (paragraph [0050], lines 1-10, paragraph [0093], lines 1-6, paragraph [0100], lines 1-6); and means for outputting at least one measure of economic value for said business transformation outsourcing service (paragraph [0050], lines 1-10, paragraph [0093], lines 1-6, paragraph [0100], lines 1-6). However, Engelking et al. does not explicitly disclose a benefits inputs and benefits simulation. It is common knowledge in the prior art that cost inputs are a form of benefits inputs (i.e. spending less money/dollars saved) since when an organization or

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business spends money on a benefit the organization or business essentially procures a benefit. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method, system, and computer-usable medium of Engelking et al. to include the features of benefits inputs and benefits simulation. The motivation for doing so would be to compute measurements regarding economic benefit to the organization or business.

Regarding to claims 2, 3, 12, 13, 19 and 20, Engelking et al. discloses performing said simulations (i.e. modeling) in different modes for different end users wherein said performing further comprises performing one or more simulations chosen from: a simulation in research and development mode (i.e. Transformation team/ Saratoga) (paragraph [0037], lines 1-7, paragraph [0040], lines 1-13), a simulation in internal use mode (i.e. external for client point of view) (paragraph [0032], lines 24-30), and a simulation in external use mode (i.e. internal for client point of view) (paragraph [0007], lines 21-27, paragraph [0032], lines 8-12, paragraph [0040], lines 1-13, paragraph [0044], lines 10-13, paragraph [0052], lines 7-12).

Regarding to claim 4, 14 and 21, Engelking et al. discloses wherein said means for performing a benefits (i.e. cost) simulation further comprises means for simulating at least one business transformation outsourcing service of human resources (paragraph [0004], lines 1-4, paragraph [0007], lines 25-27, paragraph [0035], lines 1-7) and accounting (paragraph [0035], lines 7-14).

Regarding to claims 5, 15 and 22, Engelking et al. discloses mapping (i.e. associating) various forms of said benefits simulation (i.e. costs modeling) to various forms of said business transformation outsourcing service (paragraph [0041], lines 5-9, paragraph [0158], lines 1-10).

Regarding to claims 6, 16 and 23, Engelking et al. discloses the invention substantially as claimed. Engelking et al. discloses representing various forms of said business transformations outsourcing service (paragraph [0007], lines 21-25) by utilizing various forms of said benefits (i.e. costs) simulation (i.e. paragraph [0005], lines 1-11, paragraph [0092], lines 1-4, paragraph [0093], lines 1-6). However, Engelking et al. does not explicitly disclose representing various forms of said business transformation outsourcing service mainly by utilizing various forms of said benefits (i.e. costs) simulation. It is common knowledge in the prior art to represent various forms of said business transformation outsourcing service utilizing various forms of simulations. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method, system, and computer-usable medium of Engelking et al. with the feature of representing various forms of said business transformation outsourcing service mainly by utilizing various forms of said benefits (i.e. costs) simulation. The motivation for doing so would be to represent business transformation outsourcing services based on simulation regarding economic benefits.

Regarding to claims 7, 17 and 24, Engelking et al. discloses outputting cost quantities (i.e. current and future costs) and benefit quantities (i.e. benefit summary/cash benefit) for a plurality of years (paragraph [0201], lines 1-7).

Regarding to claim 8, Engelking et al. discloses the invention substantially as claimed. Engelking et al. teaches a method of simulation (i.e. modeling) (paragraph [0006], lines 1-3), said method comprising: performing a cost simulation (paragraph [0092], lines 1-4, paragraph [0093], lines 1-6); performing a process simulation (i.e. implementation) (paragraph [0062], lines 1-11, paragraph [0092], lines 1-4, paragraph [0127], lines 1-7); performing an information

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technology simulation (i.e. technology/equipment upgrades) (paragraph [0041], lines 1-9, paragraph [0092], lines 1-4); performing a value simulation (i.e. economic impact) (paragraph [0050], lines 1-10, paragraph [0093], lines 1-6, paragraph [0100], lines 1-6); providing interactions (i.e. comparing to determine most beneficial for client) among said simulations (paragraph [0008], lines 7-11, paragraph [0034], lines 5-8, paragraph [0046], lines 4-7); and representing with said simulations the use of at least one business transformation outsourcing service (i.e. human resources) by a client organization (paragraph [0004], lines 1-4, paragraph [0007], lines 25-27, paragraph [0035], lines 1-7). However, Engelking et al. does not explicitly disclose a benefits simulation. It is common knowledge in the prior art that cost simulation are a form of benefits simulation (i.e. spending less money/dollars saved) since when an organization or business spends money on a benefit the organization or business essentially procures a benefit. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Engelking et al. with the feature of a benefits simulation. The motivation for doing so would be to compute measurements regarding economic benefits to the organization or business.

Regarding claim 9, Engelking et al. discloses the invention substantially as claimed. Engelking et al. discloses receiving for said at least one business transformation outsourcing service (paragraph [0007], lines 21-25) costs inputs (paragraph [0055], lines 5-9, paragraph [0056], lines 1-5, paragraph [0060], lines 1-2), process inputs (i.e. implementation/process costs) (paragraph [0062], lines 1-5, paragraph [0063], lines 1-9, paragraph [0088], lines 1-3 and 8-13), information technology inputs (i.e. technology costs) (paragraph [0033], lines 1-3 and 13-21, paragraph [0060], lines 12-16, paragraph [0071], lines 1-4, paragraph [0075], lines 1-4), and

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value inputs (i.e. stock price) (paragraph [0056], lines 5-9). However, Engelking et al. does not explicitly disclose benefits inputs. It is common knowledge in the prior art that cost inputs are a form of benefits inputs (i.e. spending less money/dollars saved) since when an organization or business spends money on a benefit the organization or business essentially procures a benefit. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Engelking et al. with the feature of having benefits inputs. The motivation for doing so would be to compute measurements regarding economic benefit to the organization or business.

Regarding to claim 10, Engelking et al. discloses outputting cost quantities (i.e. current and future costs) and benefit quantities (i.e. benefit summary/cash benefit) for a plurality of years (paragraph [0201], lines 1-7).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stok et al. (U.S. Pub. No. 2003/0033182 A1) teaches a system and method of business planning and/or business process redesign. Jin et al. (U.S Pat. No. 7,076,474 B2) teaches a system for simulating business processes.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Park whose telephone number is (571) 270-3547. The examiner can normally be reached on Monday - Friday (EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Cheng can be reached on (571) 272-4433. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joe H Cheng/
Supervisory Patent Examiner, Art Unit 4114

GP
10/25/07